

REMARKS

Claims 1-37 are pending in this application. By this Amendment, claims 12 and 23 are amended. Support for the claim amendments may be found, for example, on page 1, line 24 - page 2 line 19, page 5, lines 4-6, and Fig. 1. Reconsideration is respectfully requested.

Applicants gratefully acknowledge the courtesies extended to Applicants' representative at the personal interview conducted January 12, 2004. The substance of the interview is incorporated in the following remarks, which constitute Applicants' record of the interview.

The Office Action rejects claims 1-37 under 35 U.S.C. §103(a) over U.S. Patent No. 6,173,287 to Eberman et al. (hereinafter "Eberman") in view of "Beyond Paper: Supporting Active Reading with Free Form Digital Ink Annotations" to Schilit et al. (hereinafter "Schilit"). This rejection is respectfully traversed.

The Office Action admits that Eberman does not disclose "a viewing device that is distinct from an annotation device." The Office Action then relies on Schilit to provide the missing subject matter by citing the Abstract and Figure 1 of Schilit. However, the Abstract and Figure 1 of Schilit disclose "XLibris uses a commercial high-resolution pen tablet display along with a paper-like user interface to support the key affordances of paper for active reading: the reader can hold a scanned image of a page in his lap and mark on it with digital ink." The Office Action appears to be identifying the tablet display as the viewing device and the electronic pen with digital ink as the annotation device. However, this annotation device clearly does not include the other features of "an annotation linking circuit," "a database," and "a synchronizing circuit," wherein "upon synchronization by the synchronizing circuit, the at least one annotation is transferred to at least one object," as recited in claim 1, and similarly recited in claim 14.

As discussed during the personal interview, the Office Action is picking and choosing elements from the prior art to construct the invention without viewing the disclosure of the cited references or the claimed invention as a whole. The device of Schilit is intended to allow a user to make annotations directly on a displayed document, using digital ink. Therefore, the device of Schilit has no use for, nor can it use, the search circuit of Eberman that locates the at least one object to be annotated and provides an object identifier that corresponds to the at least one object. Similarly, it does not possess, nor can it use, a linking circuit, a database or a synchronizing circuit, because there is no teaching in Schilit that the annotation device can operate on any object other than that being displayed. Accordingly, one of ordinary skill would not have been motivated to combine Schilit with Eberman.

The Office Action asserts that the motivation to make the combination is that "it would have provided the capabilities for improving reading with computation have focused [sic] on creating new media-hypertext or hypermedia that define the document being read as well as the act of reading, placing them in a separate world existing [sic] books and paper documents." As agreed to during the personal interview, nowhere in Schilit or Eberman is such a motivation expressed. Applicants submit that this is merely a conclusory statement of the features that the proposed combination would possess, and not a motivation to combine Schilit with Eberman. Nowhere in Eberman is there a suggestion or teaching that generating at least one annotation using an annotation device and displaying the object with a viewing device that is distinct from the annotation device would "provide the capability for improving reading with computation." Similarly, there is no suggestion or teaching in Schilit that using a pen tablet display in a system which provides an object identifier for at least one object, generates at least one annotation, and establishes a link between the annotation and the object, yields any such advantage.

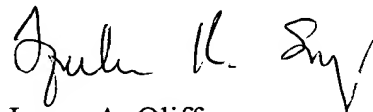
The only disclosure of such features and advantages is in the Applicants' disclosure. Therefore, it is apparent that the Office Action is relying on impermissible hindsight gained from Applicants' disclosure.

Accordingly, Applicants respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness. Applicants therefore respectfully submit that the rejection of claims 1-37 under 35 U.S.C. §103(a) is improper and should be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-37 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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